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REMARKS

Selected Claims have been amended to remove various limitations to thereby broaden the claims and to clarify that the transmission to the maker bank is not through the bank of first deposit for the check. Claims 140-180 have been withdrawn as non-elected claims. Additionally, new dependent claims 181-183 have been added to further protect applicants' invention.

Claims 47, 75 and 103 have been amended to remove the limitations "initially" and "or a print site" in the last element of the claims to provide more definiteness to the claim. These claims have also been amended to remove the language "is not a bank of first deposit for these checks," and "remote" and replacing it with —is separate from the internal deposit or cash management systems for a bank—, to thereby clarify that the central site is not operating within the internal deposit or cash management systems for a bank, whether or not it is co-located with a bank. Rather, it is a separate service system that is not a part of the internal deposit or cash management systems of the bank of first deposit. In this regard, see Fig. 1, wherein the deposit systems and cash management systems 103 and 104 for the bank of first deposit are separate from the operations of the central site 102. Also, the elements on detecting image errors at the central site and sending a communication to the remote site to obtain a correction has been removed. The element of receiving from the remote site "endorsed and/or voided check image data" has been removed. Also, the last step has been amended to include transmitting also to a Federal Reserve Bank or to a correspondent bank. Various of the dependent claims have also been amended.

GROUND OF REJECTION

The grounds of rejection to be reviewed are stated in the office action to be:

A. the rejection of claims 47-60, 75-88, 103-116 and 119-139 under 35 U.S.C. § 103(a) as being unpatentable over the four reference combination Geer, U.S. Patent No. 5,930,778 (hereinafter Geer), in view of Lowery, U.S. Patent No. 6,189,785 (hereinafter Lowery), in view of Hanaoka et al., U.S. Patent No. 6,257,783, (hereinafter Hanaoka) and further in view of Campbell et al., U.S. Patent No. 5,373,550 (hereinafter Campbell). Selected claims will be argued below under separate headings.

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ARGUMENT

A. The rejection of claims 47, 75 and 103 under 35 U.S.C. § 103 as being unpatentable over the four reference combination Geer, U.S. Patent No. 5,930,778, in view of Lowery, U.S. Patent No. 6,189,785, in view of Hanaoka et al., U.S. Patent No. 6,257,783, (hereinafter Hanaoka) and further in view of Campbell et al. (hereinafter Campbell), U.S. Patent No. 5,373,550 is respectfully traversed.

1. *The Four-Reference combination does not disclose a central operation for serving multiple different banks of first deposit located between a remote receiving site and the different banks of first deposit and receiving check image data from the remote site, as recited in the claims.*

Claims 47, 75, 103 all require the receipt of check data from a remote site, and processing and subsequent transmitting of the processed data to multiple different banks of first deposit (*"the central site receiving deposit information for a plurality of different deposit transactions, with the deposit information including for each of the different deposit transactions a deposit account designation, electronic check data and original check image data for at least one check to be deposited, wherein the central site is separate from internal deposit or cash management systems for a bank and wherein the deposit account designation for each of a plurality of the checks is to a different bank of first deposit."* *"the central site transmitting the electronic deposit data for each different deposit transaction of the plurality to a respective different one of the banks of first deposit."* These limitations are absent from the cited references.

Specifically, Geer discloses an operation and a transmission between a check payee receiving station 4 (see Fig. 1 of Geer) to a bank of first deposit 10, and from the bank of first deposit to Federal Reserve Payment System 12 (see column 9, lines 29-41). It does not disclose a central operation in advance of plural different banks of first deposit that services multiple different banks of first deposit, much less one using check image data as part of the transaction in the clearing process with maker banks or a Federal Reserve Bank or correspondent bank.

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Additionally, Geer does not disclose the sending of check images of any kind to a maker bank. Rather, in one embodiment Geer discloses the transfer of an image 7 from the remote site such as a telephone company (col. 6, line 51), to the bank of first deposit for the telephone company for purposes of "processing and archival storage." (Emphasis added.) See column 10, lines 1-3. There is no recognition of the use of an image as a fundamental part of the transaction with the maker bank or Federal Reserve Bank or correspondent bank.

Hanaoka relates to a printer and a printer control method which may be used to print checks. Note that the reference has no pertinence since the limitation that it was cited for by the examiner was dropped in a previous response.

Lowery relates to point of sale operations and transmissions of check data with no transmissions to banks of first deposit. The only communication with a bank of first deposit is by the ACH/Federal Reserve system. See element 126 in Fig. 2b.

Campbell discloses transmissions between a bank of first deposit 36 and a payor (maker) bank 34. See Figs. 1 and 2 and column 2, lines 36-49, which clarifies that the disclosed operation is for check clearing, not operation as a central receiving and distribution site in advance of and operating to transmit to multiple different banks of first deposit in multiple different deposit procedures.

Since none of the references disclose this feature of transmission to multiple different banks of first deposit, the combination of these references, even if they could be combined to obtain an operable system (which they cannot), and even if there was a motivation in the art to one of ordinary skill to take these references and create an operable system that meets this limitation (which there is not), would still not supply this deficiency.

Note that the examiner has stated that Fig. 1 shows the central site as the bank of first deposit. This is not correct. Fig. 1 is clear on its face that the bank of first deposit 101 and its cash management and deposit systems 103 and 104 are operationally separate from the central site 102 from a system standpoint. In embodiment of the invention the central site may be co-located at a bank. Whether or not there is co-location with a bank of first deposit has no bearing on the invention. The systems are separate. Applicants have demonstrated herein that one of the features of the invention is a central receiving and distribution function for

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multiple different banks of first deposit. See page 5, lines 21-24 of applicants' specification that makes reference to multiple banks of first deposit, "As an alternative, if the remote site or central site is being used as a collection center for deposits from other institutions, the deposit information can be passed to the other institutions check processing, deposit, and cash management, etc. for processing"; and page 25, lines 12-17 that makes reference to multiple central sites. In all circumstances, whether or not there is co-location, the central site system and the bank of first deposit system are different. Thus, for the purposes of this amended claim it is possible that a bank of first deposit could be co-located with the central site, but it would operate separate from the bank of first deposit, with different program systems.

Note that even assuming that the examiner was correct (which she is not) that the central site is merely a bank of first deposit (which the specification makes clear it is not, i.e., in all cases the central site program system is different from the bank of first deposit program system), none of the prior art used by the examiner discloses a bank of first deposit that operates as a receiving site for multiple other banks of first deposit. In other words, the claim is patentable even with the examiner's incorrect assertion.

The examiner states at page 5 of her office action that Geer does not disclose the situation where the central site is not a bank of first deposit for these checks. The examiner then argues that employing a central site to handle deposited checks is well known in the art, so that it "would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Geer's system to incorporate the feature above for the purpose of providing more efficiency in processing the deposited checks." However, there is no possible reason why a bank of first deposit would set up a central site to process checks for other unrelated banks of first deposit. Thus, such a modification is not obvious in Geer and would not provide "more efficiency on processing the deposited checks" in the Geer operation.

2. **The transmitting step from the central site directly or indirectly to the maker bank or a Federal Reserve Bank or a correspondent bank and not through the internal deposit or cash management systems of the bank of first deposit ("the central site transmitting electronic check data and the original check image data directly or indirectly to a maker bank or a Federal Reserve Bank or a correspondent bank with the**

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transmitting not being through the internal deposit or cash management systems of the bank of first deposit for that deposit transaction..") is not disclosed in the prior art.

The language for this element covers direct and indirect transmissions from the central site to the maker bank or the Federal Reserve Bank or correspondent bank. Note that the claim does not encompass other transmissions from the central site to the maker bank by way of the bank of first deposit. It is contemplated that clean-up reconciliation procedures could occur through the bank of first deposit, and such transmissions in themselves are not covered by the claim.

Geer does not disclose the sending of check images of any kind to a maker bank. Rather, in one embodiment Geer discloses the transfer of an image 7 from the remote site such as a telephone company (col. 6, line 51) to the bank of first deposit for the telephone company for purposes of "processing and archival storage." (Emphasis added.) See column 10, lines 1-3.

Campbell discloses a sending institution 14, e.g., one of a bank of first deposit or the payor bank, sending a check image to a receiving institution 16, e.g., the other of the bank of first deposit or the payor bank. See column 2, lines 35-49 of Campbell. Note that there is no disclosure in Campbell of a remote site sending an image of the original check. Additionally, the transmission in Campbell is between two banks. The central site, whether or not it is co-located at a banking institution for convenience, is not a bank (the programmatic systems are different). Moreover, there is no motivation disclosed why someone of ordinary skill would want to modify the Geer method so that the remote site telephone company or any other site could send check images first to a central site that processes checks for multiple different banks of first deposit, (note that the telephone company will have only one bank of first deposit for receiving its checks from the Geer site), and then bypass the telephone company's bank of first deposit and go directly to the maker bank or the Federal Reserve Bank or correspondent bank. Rather Geer discloses a lock-box operation for a telephone company, power company or other business that receives a large number of checks, each with a payment stub identifying the telephone or power company account that is being paid. See the Field of the Invention, column 1, lines 18-24; see the Background of the Invention, column 3, lines 30 - column 4, line 26; and Description of the Preferred Embodiment, column 6, lines 24-66.

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The claimed invention of claim 47 covers a comprehensive system to handle and process deposit transactions and direct them after processing to multiple banks of first deposit. The claimed system is designed to handle the problems raised by deposit processing that is based on image processing wherein multiple banks of first deposit are serviced and multiple maker banks are serviced.

The examiner is required to examine the claim as a whole. This is not being done. The sum of the individual citations in this four reference combination, even if they could be combined piecemeal (which they cannot because there is a fundamental lack of motivation to combine to obtain applicants' claimed invention) still do not meet the claim as a whole with its image data, its transmission to multiple different banks of first deposit, and its transmissions directly or indirectly to the maker bank or the Federal Reserve Bank or correspondent bank but bypassing the internal deposit or cash management systems of the bank of first deposit, in the context of the other elements.

A prima facie case of obviousness has not been made out per the MPEP and withdrawal of the rejection is respectfully requested.

The foregoing explanation applies equally to claim 75 (program product format), which tracks the limitations of claim 47 in substantial aspects, as well as to claim 103 (system format) which tracks the limitations of claim 47 in substantial aspects. Note that there are numerous dependent claims which are allowable in their own right. Only selected dependent claims will be argued at this time.

Regarding claims 52 and 53, which include various limitations relating to determining whether a maker bank requires a hard copy of a check, the examiner admits that Geer does not disclose such a limitation, but cites Campbell at column 3, lines 45-52 to make up for this deficiency. However, this citation of Campbell makes no reference to a print site. Moreover, Geer teaches away from such a combination with its statements at column 4, lines 1-9, and the description of Geer's first embodiment where the paper checks are destroyed (column 7, lines 26-27) and Geer's second embodiment where the paper checks are not printed at a remote site but rather are physically transported to the maker bank (column 10, lines 50-52).

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Regarding claim 54 relating to non-storage if an error is detected, the examiner's comments cannot stand in view of the analysis provided above for the deficiencies of Lowrey.

Regarding claim 55 relating to an electronic notification that a deposit is complete, the examiner cites Geer at column 9, lines 45-50. However, this citation in Geer relates to check dishonors by the payor bank, which is the opposite of completing a deposit at a bank of first deposit.

Regarding claim 58 relating to returns, the examiner cites Geer at column 9, lines 45-50. However, there is no reference in this citation to return check image data being sent. Likewise, the rejection of claim 59 that relates to sending return check image data directly or indirectly to the maker bank, fails for the same reason.

Claim 60 relates to determining, in a re-presentment context, whether a hard copy of the check is required. The examiner cites Geer at column 9, lines 45-50 as meeting this limitation. However, this citation of Geer does not disclose such a hard copy determination. It refers to transmission of electronic information.

Regarding claim 119 that relates to multiple remote sites, the examiner cites Geer at column 7, lines 4-25. However, Geer does not disclose "endorsing and/or voiding the original one or more checks to obtain endorsed and voided checks;" or "creating an image of each of a plurality of the endorsed and/or voided checks to obtain endorsed and/or voided check image data;" or "electronically associating the electronic deposit data, the electronic check data and the original check image data and the endorsed and/or voided check image data;" or "transmitting the electronically associated electronic check data and the original check image data and/or the endorsed and/or voided check image to the central site." Thus, the rejection of this claim cannot stand. The examiner states that Geer discloses "the plurality of remote sites are similar to the steps in claim 47 above." However, similarity is not the test and would not be upheld in court.

Regarding claim 121, the examiner states that this limitation regarding determining whether the endorsement information at the remote cite is up-to-date, and if not, then downloading the up-to-date information is obvious. It is timely requested that the examiner substantiate this statement per MPEP 2144.03. This is the second request.

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Regarding claim 122 relating to comparing an amount of one or more checks against a deposit maximum, and providing a notice if the deposit exceeds the maximum, the examiner cites Geer at column 9, lines 52-63. However, this citation relates to account balances in checking accounts or savings accounts and contains no reference to a deposit maximum or sending out a notice. Account balances in checking accounts and savings accounts have no relation to a deposit maximum.

Claim 123 relates to the remote site receiving return check image data. The rejection of the examiner relies on Geer at column 9, lines 45-50 fails for the same reason as the other return claims discussed above.

Claim 135 relates to the central site sending endorsement information to the remote site. The examiner cites Geer at column 11, lines 40-45 to meet this limitation. However, this citation has nothing to do with sending endorsement information, much less sending it from the central site.

It is noted that the Examiner has in the past taken official notice of a number of limitations in accordance with MPEP 2144.03, applicants traverse/challenge these official notice statements based on personal knowledge and request that each point of official notice be supported by a citation to a reference, as set forth by the MPEP Office requirements. This traverse of the official notice is made insofar as these statements of official notice are applied to the claims as amended.

In view of the foregoing amendments and remarks, the application is ready for allowance.

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to

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Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. § 1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date 3/4/05

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